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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/936,304	09/24/97	DONG	D 15758.705

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EXAMINER	
SCOTT JR, L	
ART UNIT	**PAPER NUMBER**
2881	

DATE MAILED: 09/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.

EXAMINER

ART UNIT	PAPER NUMBER
	13

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined. ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire THREE (3) month(s), — days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claim(s) 6 is pending in the application.
   Of the above, claim(s) _____ is withdrawn from consideration.
2. ☐ Claim(s) _____ has been canceled.
3. ☐ Claim(s) _____ is allowed.
4. ☒ Claim(s) 6 is rejected.
5. ☐ Claim(s) _____ is objected to.
6. ☐ Claim(s) _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawing(s) under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawing(s) are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction(s), filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under 35 USC 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In : line 4 of claim 6 applicant claims *an upper case for mounting the rotating shaft* ,it is not clear within the context of claim language what constitutes an *upper* case, nor is it clear how the upper case is *for mounting the rotating shaft*, claim 6 is indefinite and incomplete. In line 6 of claim 6 the recitation: *a laser projecting a beam* expresses a desired result while failing to recite the structure and/or means necessary to provide that result. Further where or how is the module housing *attached to the rotating shaft* to or for what, claim 6 is indefinite and incomplete. In lines 7 a and 8 of claim 6, the recitation: *the center ray* lacks a clear antecedent basis.In lines 6 and 7 of claim 6 what contains a laser projecting a laser beam, the module housing or the mechanical axis in the housing or both, claim 6 is indefinite and incomplete.

The amendment filed 8/23/00 is objected to under 35 U.S.C. 132 because it introduces *new matter* into the specification. 35 U.S.C. 132 states that *no amendment* shall introduce new matter into the disclosure of the invention.

Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not *described in the specification* in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed ,had possession of the claimed invention. The added material which is *not supported* by the *original disclosure* is as follows: The recitation that the motor is "*adapted to drive the shaft more than 360 degrees in a single direction* "in lines 3 and 4 of claim 6 constitutes new matter. Accordingly applicant is requested to point out where in the specification support for this exact recitation can be found.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action: A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 6 is, insofar as definite rejected under 35 U.S.C. 102(b) as *anticipated* by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kirchever et al('120) or Kirchever et al('948).

Fig.1A of Kirchever et al('120) or Kirchever et al('948). clearly discloses *the center ray of the beam is perpendicular to the shaft* . Further, although ,in the present case, the motors *use* is limited to drive the shaft in the direction of the scan angle of the laser mounted on the shaft , it is nonetheless clear that when the motor is *on* it drivers or rotates the shaft and it is *inherent* that the motor can drive the shaft, in the devices of Kirchever et al('120) or Kirchever et al('948), more than 360 degrees in a single direction, if desired;. Surely applicant is not suggesting that one of ordinary skill would not *inherently* know how to use the motor disclosed to drive the shaft more than 360 degrees in a single direction. Further, it is pointed out and applicant is reminded that : "*A reference is to be considered not only for what it expressly states, but for what it would reasonably have suggested to one of ordinary skill in the art.*"(emphasis added, see In re DeLisle, 56 CCPA 1319, 406 F.2d 1386,867 OG 722,160 USPQ 806.); clearly a reasonable suggestion here is that the motor can inherently be used to drive the shaft more than 360 degrees in a single direction, or it would have been obvious that when the motor is *on* and the shaft is oscillating or rotating, to use the motor to drive the shaft more than 360 degrees in a single direction, if desired.

Further, as to Applicant's proported point of novelty, using fig. 1A, it is clear that the exit laser beam and a mechanical axis of the housing are perpendicular to the shaft(22). The *motor coupled to the shaft* in line 3 of claim 6 would be inherent in the device since the only shaft claimed is the main shaft which must be coupled to the motor if it(the main shaft) is to rotate. Likewise since the *center ray of the laser beam and a mechanical axis of the module housing is perpendicular to the rotating shaft* .is met by the references in that clearly a mechanical axis of the housing, which is not limited by the language of the claims, can be virtually any axis including an axis perpendicular to the center ray of the beam and the rotating shaft... Applicant's device is obvious. Again it is pointed out to Applicant that the use("application") of the laser system of the prior art is not at issue , indeed the prior art laser system could be used in almost any apparatus and still be a reference against applicant's *broad* claim. Further it is pointed out that: (a) ..under section 103, not only are the teachings of the prior art taken into consideration, but also the level of ordinary skill in the pertinent art.(see In re Luck, 177 USPQ 523); and (b) ...it is well settled that the test of obviousness is not whether the features of one reference can be bodily incorporated into the structure of another, and *proper inquiry* should *not be limited* to the specific structure shown by the references, but should be into the concepts fairly contained therein, and the overriding question to be determined is whether those concepts would suggest to one skilled in the art the modifications called for by the claims.(see In re Van Beckum et al, 169 USPQ 47). When one considers these

points of law along with a *careful* comparison and review of the art of record, it is clear that Applicant's device is obvious.

Applicant is not being SENT copies of the references to: Kirchever et al('120) and Kirchever et al('512) and Kirchever et al('948) as they were supplied in a previous Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Léon Scott Jr. at telephone number (703)308-4884.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Leon Scott, Jr.
Primary Examiner

Léon Scott, Jr.
Primary Examiner
Art Unit 2881

September 20, 2000